

## **REMARKS**

### **A. Specification**

The Office Action notes the use of the trademarks ABI PRISM, GENESCAN, GENOTYPER, and GENBANK in the specification. The Office Action states that these trademarks should be capitalized and accompanied by generic terminology, and that every effort should be made to prevent their use in a manner that may adversely affect their validity.

Applicant has amended the specification by capitalizing all trademark names that were not capitalized previously, and by adding generic terminology where available. For the trademark name YO-PRO-1, Applicant has added the generic chemical name by which the dye was known at the time of filing (quinolinium,4-[(3-methyl-2(3H)-benzoxazolylidene) methyl]-1-[3-(triethylammonio) propyl]-, diiodide). For the trademark name SYBR GREEN I, Applicant has added the Chemical Abstract Service (CAS) number which was associated with the dye at the time of filing, along with a description of the distinguishing physical properties of the dye. Applicant has also added generic chemical names for the non-trademarked dyes listed at page 18 of the specification (thiazole orange, Hex, FAM, and TET). In addition, Applicant has corrected several spelling errors in the amended paragraphs. The information added to the specification consists entirely of names and definitions that were known in the art at the time of filing or correction of obvious mistakes, and as such it does not add new matter.

**B. Claim rejections – 35 U.S.C. §112, second paragraph**

Claims 9 and 19 are rejected under 35 U.S.C. §112, second paragraph, as indefinite for failing to particularly point out and distinctly claim the subject matter which the applicant regards as the invention. Specifically, the Office Action states that claims 9 and 19 are indefinite due to the recitation of the trademarked terms SYBR and YO-PRO.

Applicant has amended claims 9 and 19 by adding the generic chemical name for YO-PRO. Since no generic name exists for SYBR GREEN I, Applicant has described the dye using its CAS number and a description of its distinguishing physical properties. In addition, Applicant has added generic chemical names for the four non-trademarked dyes listed in these claims (thiazole orange, Hex, FAM, and TET).

**C. Claim rejections – double patenting**

Claims 1-9 and 12-19 are rejected under the judicially created doctrine of obviousness-type double patenting as unpatentable over claims 1-4 of U.S. Patent No. 6,280,941 B1 ("the '941 patent"). Applicant has filed a terminal disclaimer in conjunction with the present document, thereby overcoming this rejection.

**CONCLUSION**

In view of the foregoing, it is submitted that the present claims are in condition for allowance. Accordingly, Applicant respectfully requests that a Notice of Allowance be issued.

Respectfully submitted,  
Perkins Coie LLP

Date: \_\_\_\_\_

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Patrick D. Morris, Ph.D.  
Registration No. 53,351

**Correspondence Address:**

Customer No. 34055  
Perkins Coie LLP  
P.O. Box 1208  
Seattle, WA 98111-1208  
Telephone: (310) 788-9900  
Facsimile: (310) 788-3399